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March 17, 2006

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Application Serial No.: 09/776,503
Confirmation No.: 9612
Applicants: Dale Blackson, et al.
Title: System and Method for Dispensing
Digital Information from an Automated
Transaction Machine
Docket No.: D-1132 R

Sir:

Please find enclosed the Third Appeal Brief of Appellants pursuant to 37 C.F.R. § 41.37 for filing in the above-referenced application. This Appeal Brief is being filed in response to the Office Action dated October 19, 2005.

A fee (\$330) was already paid for a previous Appeal Brief. If necessary, please charge a fee (\$170) for the Appeal Brief and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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D-1132 R

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: **Dale Blackson, et al.**)
Application No.: **09/776,503**)
Confirmation No.: **9612**) Art Unit 3624
Filed: **February 2, 2001**)
Title: **System and Method for Dispensing**)
Digital Information from an)
Automated Transaction Machine) Patent Examiner
James Alpert

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**THIRD BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 41.37**

Sir:

The Appellants hereby request reinstatement of their appeal. The Appellants hereby submit their Third Appeal Brief pursuant to 37 C.F.R. § 41.37 concerning the above-referenced Application. This Third Appeal Brief is in response to the Office Action dated October 19, 2005, which reopened prosecution.

Request for treatment as a special case

This application has been pending more than five years . Thus, Appellants respectfully request that this application be treated as “special” by the Office. MPEP § 708.01(I) and 707.02.

(i)

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is
Diebold, Incorporated, an Ohio corporation.

(ii)

RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative, and assignee believe that there are no additional related appeals or interferences pertaining to this matter.

(iii)

STATUS'OF CLAIMS

Claims 1-86 are pending in the Application.

Claims rejected: 1-86

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-86, inclusive. These rejections were in the Office Action (“Action”) dated October 19, 2005.

(iv)

STATUS OF AMENDMENTS

The Action dated October 19, 2005 reopened prosecution. Appellants again respectfully request reinstatement of their appeal. Appellants' remarks in the Second Appeal Brief (filed June 23, 2004) are incorporated herein by reference.

The Action dated October 19, 2005 was not made final. Thus, no amendments to the claims were requested to be admitted after a final rejection.

(v)

SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of exemplary forms of the claimed invention:

For reasons of brevity, claim language may be referred to herein (and in Appellants' arguments) in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any generalized statement in this Appeal Brief is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language.

With respect to independent claim 1

An exemplary form of the invention is directed to an automated transaction machine apparatus (e.g., 10) that can both dispense cash and dispense digital files (e.g., MP3 sound files). The machine includes at least one computer processor (e.g., 12). The computer processor (12) is in operative connection with at least one data store (e.g., 13, 26); at least one user input device (e.g., 16, 20); a cash dispenser device (e.g., 24); and at least one output device (e.g., USB port 18, 28) (e.g., Specification page 10, line 16 to page 11, line 17; page 16, lines 21-22). The computer processor (12) is operative to cause a plurality of digital information files (e.g., MP3 sound files 44) to be retrieved from at least one digital information source (e.g., 32) located remotely from the machine and saved in the data store (13, 26) (e.g., page 13, line 14 to page 14, line 5). The input device (16) is operative to receive user input (e.g., page 12, lines 14-19). The computer processor (12) is operative to cause the cash dispenser (24) to dispense currency responsive to first user input through the input device (16) (e.g., page 13, lines 5-9).

The computer processor (12) is further operative to cause the dispense of a digital information file (e.g., MP3 sound file 44) through the output device (e.g., USB port 18)

responsive to second user input (e.g., fee authorization; page 13, lines 5-9; page 17, line 17 to page 18, line 9) through the input device (16) that corresponds to the digital information file (e.g., page 13, lines 14-20; page 16, line 19 to page 17, line 3). The computer processor (12) can cause the dispense of the same digital file (MP3 file 44) to plural users (e.g., page 9, lines 9-22; page 11, line 18-page 12, line 12; page 14, lines 3-8). Further description may be found, for example, at pages 10-18 and Figures 1-3.

With respect to independent claim 7

An exemplary form of the invention is directed to an apparatus. Reference in the disclosure for like features has previously been provided. The apparatus includes an automated transaction machine (e.g., 10) which includes at least one input device (e.g., 16, 20); a cash dispenser (e.g., 24); and at least one output device (e.g., USB port 18). The cash dispenser (24) is operative to deliver cash from the machine responsive to input to the input device (16). The output device (e.g., USB port 18) is operative to cause the delivery of digital content responsive to a digital content delivery fee authorization input to the input device (16) (e.g., page 17, line 17 to page 18, line 9). The output device (e.g., USB port 18) is operative to cause the delivery of the same digital content to different entities (e.g., page 9, lines 9-22; page 11, line 18-page 12, line 12; page 14, lines 3-8). Further description may be found, for example, at pages 10-18 and Figures 1-3.

With respect to independent claim 85

An exemplary form of the invention is directed to an apparatus. Reference in the disclosure for like features has previously been provided. The apparatus includes an automated transaction machine (e.g., 10) which includes at least one input device (e.g., 16, 20), a currency dispenser device (e.g., 24), and a file dispenser device (e.g., USB port 18, 28) (e.g., page 11, line 2 and lines 14-17). The input device (16) is operative to receive machine user input corresponding to a currency dispense, to receive machine user input corresponding to selection of a digital file (e.g., MP3 sound files 44) that is selectable to plural machine users, and to receive machine user input corresponding to a payment (e.g., page 13, lines 5-9; page 17, line 17 to page 18, line 9)) associated with dispense of the selected digital file (e.g., MP3 sounds files 44) (e.g., page 12, lines 13-16; page 12, line 20-page 13, line 9; page 17, lines 1-6). The currency dispenser (24) is operative to dispense currency (e.g., page 13, lines 5-9). The file dispenser device (e.g., USB port 18, 28) is operative to cause the dispense of the selected digital file (MP3 file 44) responsive to machine user input to the input device (16) (e.g., page 14, lines 6-8; page 14, line 21-page 15, line 2). Further description may be found, for example, at pages 10-18 and Figures 1-3.

With respect of independent claim 86

An exemplary form of the invention is directed to a method. Reference in the disclosure for like features has previously been provided. The method includes receiving machine user input corresponding to the selection of a digital file (e.g., MP3 file 44) (e.g., page 9, lines 9-23; page 14, lines 6-8; page 14 line 21-page 15, line 2). The digital file (MP3 file 44) is selectable to

plural users of the automated transaction machine (e.g., 10) via at least one input device (e.g., 16, 20). The machine (10) has a currency dispenser (24) operative to dispense currency.

The method further includes receiving machine user input (16) corresponding to a payment associated with dispense of the selected digital file (e.g., page 18, lines 4-13).

The method also includes dispensing (e.g., USB port 18) the selected digital file (MP3 file 44) responsive to machine user input (16) (e.g., page 12, lines 13-19; page 14, lines 5-8; page 17, lines 7-16). Further description may be found, for example, at pages 10-18 and Figures 1-3.

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- 1). Whether claims 55-81 are unpatentable pursuant to 35 U.S.C. § 101 as being directed to neither a process nor a machine.
- 2). Whether claims 55-81 are unpatentable pursuant to 35 U.S.C. § 112, second paragraph, as being ambiguous.
- 3). Whether claims 1-2 and 18-20 are unpatentable pursuant to 35 U.S.C. § 102(e) as being anticipated by De Leo, et al. (US 6,381,626) (hereinafter “De Leo”).
- 4). Whether claims 3-7, 13-35, 45-54, 77, and 83-86 (and 55-76 and 78-82, as best understood) are unpatentable pursuant to 35 U.S.C. § 103(a) as obvious over De Leo in view of Martin (US 5,930,765).
- 5). Whether claims 8-12 and 36-44 are unpatentable pursuant to 35 U.S.C. § 103(a) as obvious over De Leo in view of Martin and Lotspiech (US 6,748,539).

(vii)

ARGUMENT

The 35 U.S.C. § 101 Rejections

35 U.S.C. § 101

Who ever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of the title.

Claims 55-81 were rejected under 35 U.S.C. § 101 as being unpatentable. The Office alleges that claims 55-81 are directed to neither a process nor a machine, but rather embraces or overlaps two different statutory classes of invention. The Office relies on *Ex parte Lyell*, 17 U.S.P.Q.2d 1548 (Bd. Pat. App. & Inter. 1990).

From claim 2 of *Ex parte Lyell*

An automatic transmission tool in the form of a workstand and method for using same comprising:

a support means,

. . . internally splined sleeve . . .

a threaded adjustment bolt . . .

and further comprising the steps of

1. positioning the output end of an automatic transmission onto said . . . sleeve,

2. removing the internal components . . .
3. repairing and replacing said components . . .
4. adjusting said components . . .

Claim 55

The case relied upon by the Office was directed to a *single* claim that recited both an apparatus and method steps to using the apparatus. Appellants' claim 55 is not analogous to the claim in *Ex parte Lyell*. Appellants' claim 55 is clearly directed to a method.

Appellants' recited method mentions structure in carrying out the method steps. The Office has not explained how a method claim could be recited without involving structure. In following the Office's reasoning, no method claim would be permitted.

The Patent Office has recently published Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (October 25, 2005) ("Guidelines"). The Guidelines show that claim 55 recites statutory subject matter, and the 35 U.S.C. § 101 rejection should be withdrawn.

The Guidelines point out in the second paragraph that the exceptions to statutory subject matter are narrow. The exceptions include mere abstract ideas, laws of nature and natural phenomenon. None of these are encompassed by Appellants' claim 55. Again, claim 55 merely recites a method.

The assertion in the Action that the claim is not statutory because it is alleged to be encompassing different statutory forms of subject matter (i.e., a "hybrid" claim) is neither correct nor a basis for finding that subject matter is non-statutory. The Guidelines specifically note that

a Section 101 analysis is the same regardless of the form or category of invention in which a particular claim is drafted. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 U.S.P.Q.2d 1447 (Fed. Cir. 1999). Further, claim 55, which recites process steps, is not a “hybrid” claim.

The fact that the claimed subject matter produces a useful, concrete, and tangible result means that the claim is statutory. *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998).

In addition, the Office bears the burden of making a *prima facie* showing that the claimed subject matter is non-statutory. Guidelines IV(D), *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). In the present situation there has been no showing or even any allegation by the Office that the claimed subject matter of claim 55 is directed to a mere abstract idea, natural phenomenon, or law of nature. As the Office has not established or even presented a *prima facie* case of non-statutory subject matter, the Section 101 rejection is improper.

For all of these reasons it is respectfully submitted that claim 55 is statutory, that a *prima facie* showing that claim 55 is not statutory has not been made by the Office, and that the Section 101 rejection should be reversed.

The Office's attention is also directed to rejoinder. MPEP § 821.04(B).

Claims 56-81

Claims 56-81 depend from claim 55. Appellants' remarks in support of the patentability of claim 55 with regard to the 35 U.S.C. § 101 rejection are incorporated herein by reference.

Appellants respectfully submit that each of claims 56-81 is being separately argued herein (by incorporation) against the 35 U.S.C. § 101 rejection presented. In order to avoid unnecessarily repeating the argument twenty-six times, each under a different claim heading, Appellants herein respectively incorporate the claim 55 argument twenty-six times for each respective rejected claim 56-81. That is, Appellants herein respectively incorporate the claim 55 argument to each respective separate rejection of individual claims 56, 57, 58, . . . and 81.

For reasons already discussed, claims 56-81 are statutory and the Section 101 rejections should be reversed.

The 35 U.S.C. § 112, Second Paragraph, Rejections

Claims 55-81 were rejected as being ambiguous.

Claim 55

Appellants' remarks against the 35 U.S.C. § 101 rejection of claim 55 are incorporated herein by reference. For reasons already discussed, Appellants' claim 55 is clearly directed to a method. Thus, claim 55 is not ambiguous.

A claim is not indefinite merely because it makes reference to another claim. *Ex parte Porter*, 25 USPQ2d 1144 (Bd. Pat. App. & Inter. 1992). MPEP § 2173.05(f).

The reason for rejection does not constitute a valid basis for rejection pursuant to 35 U.S.C. § 112, second paragraph. Claims 55 meets the requirements of 35 U.S.C. § 112, second paragraph. Appellants respectfully submit that the rejection should be reversed.

Claims 56-81

Claims 56-81 depend from claim 55. Appellants' remarks in support of the patentability of claim 55 with regard to the 35 U.S.C. § 112, second paragraph, rejection are incorporated herein by reference.

Appellants respectfully submit that each of claims 56-81 are being separately argued herein (by incorporation) against the 35 U.S.C. § 112, second paragraph, rejection presented. In order to avoid unnecessarily repeating the argument twenty-six times, each under a different claim heading, Appellants herein respectively incorporate the claim 55 argument twenty-six times for each respective rejected claim 56-81. That is, Appellants herein respectively

incorporate the claim 55 argument to each respective separate rejection of individual claims 56, 57, 58, . . . and 81.

For reasons already discussed, claims 56-81 meet the requirements of 35 U.S.C. § 112, second paragraph. Appellants respectfully submit that the rejections should be reversed.

The 35 U.S.C. § 102 Rejections

The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Bariant, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is “necessarily present” in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

De Leo does not anticipate the claims

Claims 1-2 and 18-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by De Leo.

Claim 1

De Leo does not teach the recited features and relationships. De Leo does not teach the capability to both dispense currency responsive to a first user input *and* dispense a digital information file responsive to a second user input. De Leo does not teach an automated transaction machine apparatus that provides a user thereof the ability to cause a currency dispense responsive to a first input and cause a digital information file dispense responsive to a second input, especially where the second input “corresponds” to the digital information file.

De Leo is directed to providing a non-transaction message (i.e., advertisement; col. 6, lines 53-54) to a user during ATM operation (e.g., dispensing cash). That is, De Leo desires that operation of the ATM be coordinated with the advertisement presentation. This coordination gives the user the impression that the operating ATM (which the user can hear) is working (to dispense cash) on their behalf. De Leo reasons that because the user can hear the cash dispenser operating (i.e., hear the ATM working) during the advertisement, the user will have a positive disposition toward the advertisement. Likewise, De Leo is concerned that presenting an advertisement prior to approval of the user’s requested transaction (which leads to operation of the ATM) may cause a negative impression with the user. That is, presenting an advertisement (too soon) without coordination with ATM operation may result in the user having a negative disposition toward the advertisement. Particularly note De Leo at col. 7, line 47 to col. 8, line 20, and the Abstract.

Where does De Leo teach a second user input? De Leo does not teach the dispense of a digital information file in response to user (second) input. De Leo has host-controlled ATM video advertising. In De Leo a non-transaction message is displayed in response to transaction approval by the host (col. 2, lines 9-15; col. 8, lines 18-21; Figure 4). De Leo does not teach that a non-transaction message is displayed in response to user input, especially where the (second) input differs from another (first) input, and where the (second) input “corresponds” to a digital information file.

Where does De Leo teach a (second) user input (being different from a first input) that results in an advertisement presentation? Where does De Leo teach that a non-transaction message is displayed in response to a digital information file dispense (second) user input instead of a cash dispense transaction (first) user input? The only input provided by a user in De Leo is transaction data input for a requested transaction (e.g., cash dispense transaction). After all of this transaction data has been entered by the user, then the transaction approval request containing the user entered data (regarding the requested transaction) is sent to the host (col. 7, lines 5-21, particularly lines 18-21). After the transaction is approved by the host, then a signal is sent to the terminal causing the display of a non-transaction message (col. 7, lines 47-50). A user in De Leo does not provide a separate (second) input that corresponds to the dispense of a digital information file. Exactly where does De Leo provide a (second) input (different than the transaction data first input) that causes a digital information file to be dispensed? He does not. Nor can he anticipate claim 1.

De Leo specifically teaches that it is not preferable to display a non-transaction message prior to transaction approval (col. 2, lines 12-13; col. 8, lines 18-20). Nevertheless, even if a

message were somehow displayed prior to transaction approval, it would still be displayed after all user transaction inputs were completed (col. 8, lines 14-16). Thus, De Leo does not teach an arrangement in which a user can provide a first input to cause currency dispensing and can provide another second input to cause digital information file dispensing.

The activities in De Leo occur after user input has been completed. The activities (e.g., cash dispensing and advertising) in De Leo are (at best) responsive to the same user input, not separate inputs. De Leo's cash dispensing and advertising are coupled. For example, they are coupled via a common (first) input, which further enables them to be coupled in coordinated timing.

Furthermore, De Leo's user inputs are (at best) directed to a terminal transaction, e.g., cash dispensing. Where does De Leo teach a (second, digital file) "user input . . . that corresponds to the at least one digital information file"? At best, in De Leo the ATM host does the advertising selecting. The ATM user is not able to do the selecting.

Further, where does De Leo teach that a (second) user input that "corresponds" to a digital information file, causes the dispense of that digital information file through an output device of the machine? At best, De Leo presents an advertisement. De Leo does not teach a cash dispensing automated transaction machine apparatus that enables both the *dispense* of currency responsive to first user input and the *dispense* of a digital information file responsive to second user input. De Leo does not provide a first user service (dispense of currency) responsive to first user input *and* provide a second user service (dispense of a digital file) responsive to second user input.

For the reasons presented herein, De Leo does not anticipate claim 1. Thus, Appellants respectfully submit that the 35 U.S.C. § 102(e) rejection should be reversed.

Claim 2

Claim 2 depends from claim 1. De Leo further does not teach a card reader device to read account indicia from a card, where one or more fees can be charged to the read account corresponding to both a currency dispense and a digital information file dispense. De Leo does not anticipate claim 2.

Claim 18

Claim 18 depends from claim 13/7. Appellants respectfully submit that the Office is committing prejudicial error by addressing only some of the recited features and relationships. The subject matter of claims 7 and 13 has not been addressed. The error deprives Appellants of their administrative due process rights (e.g., timely notice of the Office's position and opportunity for unhindered response thereto).

Nevertheless, De Leo further does not teach the ability to have digital content delivered from a digital content data store in the manner recited. De Leo does not anticipate claim 18. The Action's obviousness type rejection of claim 18, which additionally relies on Martin, is further evidence against the alleged anticipation.

Claim 19

Claim 19 depends from claim 18/13/7. Again, Appellants respectfully submit that the Office is committing prejudicial error. Nevertheless, De Leo further does not teach the ability to have digital content delivered from a local content data store located in the machine in the

manner recited. De Leo does not anticipate claim 19. The Action's obviousness type rejection of claim 19, which additionally relies on Martin, is further evidence against the alleged anticipation.

Claim 20

Claim 20 depends from claim 18/13/7. Again, Appellants respectfully submit that the Office is committing prejudicial error. Nevertheless, De Leo further does not teach a network in operative connection with a cash dispensing automated transaction machine, and a remote computer in operative connection with the network, and a content data store (from which the digital content is delivered) in the remote computer. De Leo does not anticipate claim 20. The Action's obviousness type rejection of claim 20, which additionally relies on Martin, is further evidence against the alleged anticipation.

The 35 U.S.C. § 103 (a) Rejections

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembicza*k, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Evidence of record must teach or suggest the recited features. An assertion of knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Patentability determination must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action requiring appeal does not meet these burdens.

**The Claims Are Not Obvious Over
De Leo in view of Martin**

Claims 3-7, 13-35, 45-77, and 78-86 were rejected under 35 U.S.C. § 103(a) as being unpatentable over De Leo in view of Martin.

Claim 3

Appellants' remarks in support of the patentability of claims 1 and 7 are incorporated herein by reference. Claim 3 depends from claim 1. The references, taken alone or in combination, further do not teach or suggest an automated transaction machine apparatus with the ability to both dispense currency responsive to a first user input *and* dispense a digital sound recording file responsive to a second user input.

The Action (on page 6) admits that De Leo does not teach a digital sound recording file. The Office relies on Martin. However, Martin cannot alleviate the admitted deficiencies of De Leo as he does not teach or suggest the recited features and relationships not found in De Leo. Martin is non analogous art to both De Leo and the recited invention. Martin is directed to a jukebox. Martin is not pertinent to De Leo's cash dispensing ATM. It would not have been obvious to have modified De Leo's ATM to include a jukebox. Likewise, it would not have been obvious to have modified Martin's jukebox to include an ATM.

Additionally, De Leo's ATM has no desire or need for Martin's jukebox songs. De Leo's video (MPEG) commercial messages already have their own sound (col. 3, line 53). Thus, De Leo has no use for Martin's sound.

Furthermore, in the advertising of De Leo “preferably all messages have a fixed time duration, such as 15 seconds” (col. 7, lines 50-53). Thus, De Leo teaches away from modifying the ATM to play jukebox songs. De Leo also teaches against customers having to wait in line (col. 3, line 7). Thus, it would not have been obvious to have had De Leo’s valuable ATM customers wait in line an even longer time due to songs being played by another person (who may not even be performing a banking transaction). Nor would waiting customers of different generations and tastes appreciate hearing songs they would consider undesirable. Thus, De Leo teaches against the alleged modification.

Furthermore, the ATM of De Leo is not structurally and functionally capable of being modified with the teaching of Martin. The structure and function of Martin is incompatible with the structure and function of De Leo. For example, no evidence has been presented that De Leo’s ATM is sized for including a jukebox.

Nor is De Leo capable of downloading songs in the manner required by Martin, such as from the Internet (Martin at col. 5, lines 43-50). Where does De Leo teach or suggest an ATM on the Internet? Contrarily, De Leo teaches away from using Internet communication. De Leo teaches that ATMs typically communicate with their host utilizing a dedicated land line (col. 4, lines 9-12). Proprietary lines are typically used for reasons of security. Martin’s transmission of jukebox songs does not need security. It would not have been obvious to one having ordinary skill in the art to have discarded De Leo’s secure proprietary line form of communication so jukebox songs could be played, as alleged in the Action.

De Leo is also not capable of communicating in the manner required by Martin, such as device-to-device updating (Martin at col. 6, lines 47-67). De Leo requires host-to-ATMs

communication. De Leo does not permit ATM-to-ATM communication. Nor does the record provide prior art evidence of any ATM-to-ATM communication format. It would not have been obvious to one having ordinary skill in the art to have changed De Leo's host-to-ATM form of communication for an ATM-to-ATM form of communication, as would be required in De Leo with the alleged modification thereof by Martin.

De Leo's requirement for short (15 second) advertising messages at the ATM does not permit the playing of jukebox songs. De Leo's desire for secure proprietary lines does not permit the necessary downloading requirements of Martin's invention. De Leo's host-to-ATM form of communication does not permit Martin's required device-to-device form of communication. Again, the ATM of De Leo is not structurally and functionally capable of being modified with the teaching of Martin. De Leo's own teachings defeat the Office's attempt to modify De Leo with Martin's teaching (and defeats the Office's reasoning for rejection).

Even if it were somehow possible (which it is not) to combine the teachings of De Leo and Martin, the alleged modification to De Leo would result in improperly destroying the specifically disclosed structure and utility of De Leo teaching. However, an obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference.

In re Fine, 837 F.2d 1071, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Also, since the Action does not explain the rejections with reasonable specificity (e.g., by not explaining how De Leo could be structurally and functionally modified), it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

The attempt to modify De Leo with Martin's jukebox is clearly an attempt at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Appellants' disclosure.

The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified De Leo as alleged to have produced the recited invention.

The references are devoid of any teaching, suggestion, or motivation for combining features thereof so as to produce the recited invention. The attempt to modify De Leo with Martin's jukebox songs is clearly an attempt at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Appellants' disclosure.

The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified De Leo as alleged to have produced the recited invention.

Claim 4

Claim 4 depends on claim 3/1. The Action (on page 6) admits that the only applied references are devoid of any teaching, suggestion, or motivation for combining features thereof so as to produce the recited invention. The Action (on page 6) admits that neither De Leo nor

Martin teach or suggest MP3 files. That is, the Action admits that the record lacks substantial evidence support for the rejection. Appellants respectfully submit that in light of the admitted failure of the only applied references to teach or suggest all of the recited features and relationships, combined with the lack of any other supporting evidence of record, the rejection is not legally valid. *In re Zurko*, supra. *In re Lee*, supra. It follows that a *prima facie* case of obviousness has not been established. It further follows that it would not have been obvious to have structurally and functionally modified De Leo's ATM to dispense MP3 files.

Claim 5

Claim 4 depends on claim 3/1. In an exemplary arrangement, audio outputs enable the user to sample the available digital sound recording file (page 12, lines 11-12). For reasons already discussed, it would not have been obvious to have modified De Leo's ATM to play jukebox songs, as alleged by the Office. The Office has not established a *prima facie* showing of obviousness.

Claim 6

Claim 6 depends on claim 1. The Action (on page 6) admits that neither De Leo nor Martin teach or suggest a licensing fee. That is, the Action admits that the record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra. Note Appellants' previous remarks regarding claim 4. It further follows that it would not have been obvious to have structurally and functionally modified De Leo's ATM to transfer a digital file licensing fee to a licensing entity. It follows that a *prima facie* case of obviousness has not been established.

Claim 7

Appellants' remarks in support of the patentability of claims 1 and 3 are incorporated herein by reference. For reasons already discussed (claim 1 remarks), the references also do not teach or suggest a cash dispensing automated transaction machine with the ability to both deliver (dispense) cash from the machine responsive to input (a "first" input in claim 1) to the machine *and* deliver (dispense) digital content (digital file) responsive to a fee authorization input (a "second" input in claim 1) to the machine.

Neither De Leo nor Martin, taken alone or in combination, disclose or suggest an automated transaction machine that includes both a cash dispenser that can deliver cash responsive to input to an input device of the machine and an output device that can cause the delivery of digital content responsive to input of a digital content delivery fee authorization to an input device of the machine.

The Action (on page 6) admits that De Leo does not teach or suggest "fee authorization input, and the delivery of content to different entities". The Office relies on Martin. However, Martin cannot alleviate the admitted deficiencies of De Leo as he does not teach or suggest the recited features and relationships not found in De Leo. As Martin cannot alleviate the admitted deficiencies of De Leo, the combination thereof (if somehow even possible) could not have resulted in the recited invention.

As previously discussed (claim 1), Martin is non analogous art to both De Leo and the recited invention. Martin is directed to a jukebox. Martin is not pertinent to De Leo's cash dispensing ATM. Nor does Martin (or De Leo) teach or suggest adding a jukebox to a cash dispensing ATM. It would not have been obvious to have modified Martin's jukebox to include

an ATM. Likewise, it would not have been obvious to have modified De Leo's ATM to include a jukebox.

Additionally, De Leo's ATM has no desire or need for Martin's jukebox or jukebox songs. Rather, De Leo teaches away from any need of jukebox songs. De Leo has video commercial messages. These (MPEG) commercial messages already have their own sound (col. 3, line 53). De Leo's advertising presentations do not relate to or have any need of Martin's jukebox songs.

Furthermore, De Leo teaches that "preferably all messages have a fixed time duration, such as 15 seconds" (col. 7, lines 50-53). Thus, De Leo teaches away from modifying the ATM to include a jukebox and to play (lengthy) jukebox songs. It follows that neither De Leo nor Martin teach or suggest a cash delivering automated transaction machine with the further ability to deliver digital content responsive to input to the machine.

Martin also does not teach or suggest the ability to deliver digital content responsive to a fee authorization input to the jukebox. The Office relies on Martin at col. 5, lines 12-17 for allegedly teaching a customer providing a delivery fee authorization input to the jukebox. However, the Office is silent on how input of coins/bills into a jukebox by a customer relates to authorization of a delivery fee. What delivery fee is being approved by input by the customer? What delivery fee does a customer authorize by input before a song is played? In Martin a customer inserts their money (e.g., quarter), selects a song, and the song is played. There is no need for a customer in Martin to provide any input to authorize any delivery fee.

De Leo does not charge a fee for the advertisement presentations. Nor would it have been obvious to have modified De Leo to charge such a fee. Nor does De Leo have any digital content delivery fee authorization input structure, especially at an automated transaction machine.

The combined references do not teach or suggest charging a fee for delivery of digital content with regard to an automated transaction machine that is capable of delivering cash. The combined references also do not teach or suggest an automated transaction machine capable of causing the delivery of both cash (via a cash dispenser) and digital content (via fee authorization input). Where do the combined references teach or suggest delivering digital content responsive to the inputting of delivery fee authorization at a cash delivering automated transaction machine? The combined references do not teach or suggest the ability to provide a fee authorizing input at a cash delivering automated transaction machine for delivery of digital content. Where do the combined references teach or suggest a cash dispensing automated transaction machine having an input device that can receive fee authorization for delivery of digital content, and an output device that can cause the delivery of the digital content responsive to the authorization input? The combined references do not teach or suggest the recited relationship between at least one input device and at least one output device of a cash delivering automated transaction machine, especially with regard to delivery of digital content and fee authorization therefor.

Thus, neither Martin (nor De Leo, as admitted by the Office) teach or suggest delivering digital content responsive to a fee authorization input to the machine, especially a cash delivering automated transaction machine. Nor would the alleged modification to De Leo (if somehow even possible) have resulted in the recited invention.

The references are devoid of any teaching, suggestion, or motivation for combining features thereof so as to produce the recited invention. The rejection is absent any prior art evidence or support whatsoever for modifying De Leo's ATM to include a jukebox, especially when De Leo teaches away from such modification (as previously discussed). There is no common link between De Leo's ATM and Martin's jukebox. The Office has not presented any reasonable motivation for modifying the teaching of De Leo with the disparate teachings of Martin in the manner alleged.

Nor is De Leo structurally and functionally capable of including a jukebox. Nor does the Action explain how De Leo could be structurally and functionally modified as alleged, especially to overcome the admitted deficiencies therein. As previously discussed (claim 3 remarks), there is no evidence that the ATM of De Leo is structurally and functionally capable of being modified with the teaching of Martin. De Leo's requirement for short (15 second) advertising messages at the ATM does not permit the playing of jukebox songs. De Leo's desire for secure proprietary lines is contrary to the downloading requirements of Martin's invention. De Leo's host-to-ATM form of communication is contrary to Martin's device-to-device form of communication. Nor would ATM customers waiting in line appreciate the additional wait/noise due to songs being played. Thus, De Leo teaches away from modifying the ATM to play jukebox songs. De Leo's own teachings defeat the Office's attempt to modify De Leo with Martin's teaching (and defeats the Office's reasoning for rejection).

As previously discussed (claim 3 remarks), the alleged modification to De Leo would result in improperly destroying the specifically disclosed utility or advantage taught by De Leo. An obviousness rejection cannot be based on a combination of features in references if making

the combination would result in destroying the utility or advantage of the device shown in the prior art reference. *In re Fine*, supra. Also, since the Action does not explain the rejections with reasonable specificity (e.g., by not explaining how De Leo could be modified), it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, supra.

The attempt to modify De Leo with Martin's jukebox is clearly an attempt at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra. The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Appellants' disclosure.

The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified De Leo as alleged to have produced the recited invention.

Claim 13

Claim 13 depends on claim 7. The Action (on page 7) alleges that the recited features "are all inherent properties of a De Leo/Martin combination". Appellants respectfully disagree. For reasons already discussed, it would not have been obvious to have combined the incompatible teachings of the references as alleged by the Office. Even if it were somehow possible (which it is not) to combine as alleged, the result still would not have produced the recited invention.

For example, where do the references teach or suggest a machine processor in operative connection with each of the machine's account input device, the machine's cash delivery dispenser, and the machine's digital content delivery output device, especially where the

processor can cause the account to be charged for at least one of delivered cash and digital content? Where do the references teach or suggest an ATM charging an account for delivering jukebox songs, as apparently alleged in the Action? The Office has not established a *prima facie* showing of obviousness.

Claim 14

Claim 14 depends on claim 13/7. The references further do not teach or suggest a machine processor that can cause a card read account to be charged for at least one of delivered cash and digital content. The Office has not established a *prima facie* showing of obviousness.

Claim 15

Claim 15 depends on claim 13/7. The references further do not teach or suggest a machine processor that can cause a selected portion of digital content to be delivered responsive to selected input corresponding to the selected portion, and cause content indicia corresponding to the digital content to be output. The Office has not established a *prima facie* showing of obviousness.

Claim 16

Claim 16 depends on claim 15/13/7. The references further do not teach or suggest a machine processor that can cause the content indicia corresponding to the digital content to be output through a display device. The Office has not established a *prima facie* showing of obviousness.

Claim 17

Claim 17 depends on claim 16/15/13/7. The references further do not teach or suggest that content indicia corresponding to plural digital content portions includes a graphic image

corresponding to a portion of the digital content. Why would a jukebox dispense image files, as apparently alleged in the Action? The Office has not established a *prima facie* showing of obviousness.

Claim 18

Claim 18 depends on claim 13/7. For reasons already discussed, the references further do not teach or suggest a digital content data store from which the digital content can be delivered. The Action (on page 7) alleges that De Leo has MPEG video while Martin has digital music. As previously discussed, MPEG video already has audio. Thus, De Leo has no need for Martin's sound. The Office has not established a *prima facie* showing of obviousness.

Claim 19

Claim 19 depends on claim 18/13/7. For reasons already discussed, the references further do not teach or suggest a local content data store located in the machine. Where do the references teach or suggest an ATM storing jukebox songs, as apparently alleged in the Action? The Office has not established a *prima facie* showing of obviousness.

Claim 20

Claim 20 depends on claim 18/13/7. For reasons already discussed, the references further do not teach or suggest the relationships among a machine, network, and remote computer having the content data store. Where do the references teach or suggest an ATM and a remote computer on the same network, where jukebox songs are stored on the remote computer (from which the songs can be retrieved for delivery at the ATM), as apparently alleged in the Action? The Office has not established a *prima facie* showing of obviousness.

Claim 21

Claim 16 depends on claim 20/18/13/7. The references further do not teach or suggest a financial transaction computer on the network, where the machine processor can cause the account to be charged through communication with the financial transaction computer via the network. Where do the references teach or suggest an ATM, a remote computer, and a financial transaction computer all on the same network, where jukebox songs are stored on the remote computer (from which the songs can be retrieved for delivery at the ATM) and the ATM can cause an account to be charged through the financial transaction computer for delivery of a song, as apparently alleged in the Action? The Office has not established a *prima facie* showing of obviousness.

Claim 22

Claim 22 depends on claim 18/13/7. The references further do not teach or suggest a cash dispensing automated transaction machine with an input device that can receive an inputted network delivery address. It follows that the references cannot teach or suggest that the machine processor can cause digital content to be delivered through a network to the address. The Office has not established a *prima facie* showing of obviousness.

Claim 23

Claim 23 depends on claim 19/18/13/7. For reasons already discussed, the references further do not teach or suggest an ATM and a remote computer on the same network, where jukebox songs are stored on *both* the ATM *and* the remote computer (from which the songs can be retrieved for delivery at the ATM), as apparently alleged in the Action? The Office has not established a *prima facie* showing of obviousness.

Claim 24

Claim 24 depends on claim 23/19/18/13/7. For reasons already discussed, the references further do not teach or suggest an ATM with the ability to selectively deliver jukebox songs from *either* a local data store at the ATM *or* a remote data store, in response to input to the ATM, as apparently alleged in the Action. The Office has not established a *prima facie* showing of obviousness.

Claim 25

Claim 25 depends on claim 23/19/18/13/7. For reasons already discussed, the references further do not teach or suggest an ATM with the ability to cause jukebox songs (stored in a remote data store) to be stored in a local data store at the ATM, as apparently alleged in the Action. The Office has not established a *prima facie* showing of obviousness.

Claim 26

Claim 26 depends on claim 25/23/19/18/13/7. For reasons already discussed, the references further do not teach or suggest an ATM with the ability to periodically cause selected jukebox songs (stored in a remote data store) to be stored in a local data store at the ATM, as apparently alleged in the Action. Where does Martin teach or suggest “periodic downloading” of songs to an ATM, as apparently alleged in the Action (at page 7). Again, the references do not teach or suggest any ATM/jukebox relationship. Nor has the Office established a *prima facie* showing of obviousness.

Claim 27

Claim 27 depends on claim 26/25/23/19/18/13/7. The provided reason for the rejection is without legal basis. The references do not teach or suggest the recited structural and functional

capabilities. For reasons already discussed, the references do not teach or suggest an ATM with the ability to periodically cause selected popular songs (stored in a remote data store) to be stored in a local data store at the ATM, as apparently alleged in the Action. The Office has not established a *prima facie* showing of obviousness.

Claim 28

Claim 28 depends on claim 26/25/23/19/18/13/7. The provided reason for the rejection is without legal basis. For reasons already discussed, the references further do not teach or suggest a cash dispensing automated transaction machine with the ability to periodically cause a selected book sound file (stored in a remote data store) to be stored in a local data store. The Office has not established a *prima facie* showing of obviousness.

Claim 29

Claim 29 depends on claim 26/25/23/19/18/13/7. The provided reason for the rejection is without legal basis. For reasons already discussed, the references further do not teach or suggest a cash dispensing automated transaction machine with the ability to periodically cause a selected movie file (stored in a remote data store) to be stored in a local data store. The Office has not established a *prima facie* showing of obviousness.

Claim 30

Claim 30 depends on claim 27/26/25/23/19/18/13/7. The provided reason for the rejection is without legal basis. For reasons already discussed, the references further do not teach or suggest a cash dispensing automated transaction machine with the ability to periodically cause a selected popular song (and a graphic image corresponding to the song) to be stored in a local

data store at the machine. Why would a jukebox store image files, as apparently alleged in the Action? The Office has not established a *prima facie* showing of obviousness.

Claim 31

Claim 31 depends on claim 13/7. As previously discussed, it would not have been obvious to have combined the incompatible teachings of the references as alleged by the Office. Even if it were somehow possible (which it is not) to combine as alleged, the result still would not have produced the recited invention.

For reasons already discussed, the references further do not teach or suggest a machine processor in operative connection with the machine's input device, the machine's cash dispenser, and the machine's digital content delivery output device, especially where the processor can cause an inputted account to be charged responsive to communication through a network with a financial transaction computer. The Office has not established a *prima facie* showing of obviousness.

Claim 32

Claim 32 depends on claim 31/13/7. For reasons already discussed, the references further do not teach or suggest a financial transaction computer including a source account associated with a digital content source, and where the source account is credited responsive to delivery of digital content to an output device of a cash dispensing automated transaction machine. The Office has not established a *prima facie* showing of obviousness.

Claim 33

Claim 33 depends on claim 31/13/7. The Action (on page 6) admits that neither De Leo nor Martin teach or suggest licensing. That is, the Action admits that the record lacks substantial

evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra. Nevertheless, the references do not teach or suggest a financial transaction computer including a licensing account associated with a licensing entity for the digital content, and where the licensing account is credited responsive to delivery of digital content to an output device of a cash dispensing automated transaction machine. The Office has not established a *prima facie* showing of obviousness.

Claim 34

Claim 34 depends on claim 31/13/7. The references further do not teach or suggest the ability to debit a machine user's account responsive to either delivery of cash or delivery of digital content. The Office has not established a *prima facie* showing of obviousness.

Claim 35

Claim 35 depends on claim 31/13/7. The references further do not teach or suggest the ability of a machine processor to cause funds to be transferred from one account to a content prepay account, and where the processor can further cause the content prepay account to be debited responsive to the delivery of the digital content to an output device of the cash dispensing automated transaction machine. The Office has not established a *prima facie* showing of obviousness.

Claim 45

Claim 45 depends on claim 31/13/7. As previously discussed, De Leo's MPEG files (which already have their own sound) teach away from any need of jukebox songs. Nor do De Leo's advertising presentations relate to or have any need of jukebox songs.

The references do not teach or suggest a cash dispensing automated transaction machine that has an output device that includes a sound system (claim 45), where the machine can deliver digital content through the sound system responsive to a fee authorization input to the input device (claim 7), and where the machine processor can cause an inputted account to be charged for the delivered digital content (claim 13) responsive to communication through a network with the financial transaction computer (claim 31). The Office has not established a *prima facie* showing of obviousness.

Claim 46

Claim 46 depends on claim 7. As previously discussed, it would not have been obvious to have combined the incompatible teachings of the references as alleged by the Office. Even if it were somehow possible (which it is not) to combine as alleged, the result still would not have produced the recited invention. The references further do not teach or suggest an ATM that can cause the delivery of digital content through the ATM's sound system responsive to a fee authorization input to the ATM's input device, as apparently alleged in the Action. The Office has not established a *prima facie* showing of obviousness.

Claim 47

Claim 47 depends on claim 31/13/7. The references further do not teach or suggest a cash dispensing automated transaction machine that has an audiovisual output device (claim 47), where the machine can deliver digital content as audiovisual outputs through the audiovisual output device (claim 47) responsive to a fee authorization input to the input device (claim 7), and where the machine processor can cause an inputted account to be charged for the delivered digital content (claim 13) responsive to communication through a network with the financial

transaction computer (claim 31). Why would a jukebox dispense audiovisual files, as apparently alleged in the Action? The Office has not established a *prima facie* showing of obviousness.

Claim 48

Claim 48 depends on claim 7. As previously discussed, it would not have been obvious to have combined the incompatible teachings of the references as alleged by the Office. Even if it were somehow possible (which it is not) to combine as alleged, the result still would not have produced the recited invention. The references further do not teach or suggest an ATM that can cause the delivery of digital content through the ATM's audiovisual output device responsive to a fee authorization input to the ATM's input device, as apparently alleged in the Action. Why would a jukebox dispense audiovisual files, as apparently alleged in the Action? The Office has not established a *prima facie* showing of obviousness.

Claim 49

Claim 49 depends on claim 31/13/7. The Action (on page 8) admits that neither De Leo nor Martin teach or suggest printing out the digital content. That is, the Action admits that the record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra.

Nevertheless, the references further do not teach or suggest a cash dispensing automated transaction machine that can deliver digital content via printing responsive to a fee authorization input to the input device (claim 7), and where the machine processor can cause an inputted account to be charged for the delivered digital content (claim 13) responsive to communication through a network with the financial transaction computer (claim 31). The Office has not established a *prima facie* showing of obviousness.

Claim 50

Claim 50 depends on claim 7. The Action (on page 8) admits that neither De Leo nor Martin teach or suggest printing out the digital content. That is, the Action admits that the record lacks substantial evidence support for the rejection. *In re Zurko*, *supra*. *In re Lee*, *supra*.

As previously discussed, it would not have been obvious to have combined the incompatible teachings of the references as alleged by the Office. Even if it were somehow possible (which it is not) to combine as alleged, the result still would not have produced the recited invention. The references further do not teach or suggest an ATM that can cause the delivery of digital content through a printer responsive to a fee authorization input to the ATM's input device, as apparently alleged in the Action. The Office has not established a *prima facie* showing of obviousness.

Claim 51

Claim 51 depends on claim 46/7. The Action (on page 8) alleges that a restaurant owner is charged fees for a jukebox. Appellants respectfully disagree with this allegation. The record also lacks support for the allegation. Further, one skilled in the restaurant art would recognize that the restaurant owner typically does not own the jukebox but instead gets a share of the money taken in by the jukebox. That is, the restaurant owner does not pay a fee but rather gets a fee for making available someone else's jukebox.

Nevertheless, the references do not teach or suggest an ATM located in an establishment, where the ATM can cause the delivery of digital content through the ATM's sound system responsive to a fee authorization input to the ATM's input device, and the ATM can also cause an account of the establishment operator to be charged for the delivered digital content, as

apparently alleged in the Action. The Office has not established a *prima facie* showing of obviousness.

Claim 52

Claim 52 depends on claim 48/7. The Action (on page 8) alleges that a restaurant owner is charged fees for a jukebox. As discussed above (claim 51 remarks), Appellants respectfully disagree with the allegation. Regardless, the references do not teach or suggest an ATM that can cause the delivery of digital content through the ATM's audiovisual output device responsive to a fee authorization input to the ATM's input device, and the ATM can also cause an account of the establishment operator to be charged for the delivered digital content, as apparently alleged in the Action. The Office has not established a *prima facie* showing of obviousness.

Claim 53

Claim 53 depends on claim 7. The references further do not teach or suggest a cash dispensing automated transaction machine that can deliver digital content responsive to a fee authorization input to the machine's input device and responsive to deposit of cash into the machine's currency acceptor. The Office has not established a *prima facie* showing of obviousness.

Claim 54

Claim 54 depends on claim 47/31/13/7. The references further do not teach or suggest a cash dispensing automated transaction machine that can deliver digital content responsive to a fee authorization input to the machine's input device and responsive to deposit of cash into the machine's currency acceptor. That is, the references do not teach or suggest a cash dispensing automated transaction machine that has an audiovisual output device (claim 47), where the

machine can deliver digital content as audiovisual outputs through the audiovisual output device (claim 47) responsive to a fee authorization input to the input device (claim 7), where the machine processor can cause an inputted account to be charged for the delivered digital content (claim 13) responsive to communication through a network with the financial transaction computer (claim 31), and where the machine can deliver digital content responsive to deposit of cash into the machine's currency acceptor (claim 54). The Office has not established a *prima facie* showing of obviousness.

Claim 55

The references further do not teach or suggest the ability to provide account identifying input, provide dispense input, and dispense either cash or digital content responsive to the dispense input. Where do the references teach or suggest providing account data to an ATM, requesting a jukebox song from the ATM, and playing the requested jukebox song at the ATM, as apparently alleged in the Action? Where does Martin teach or suggest a need to provide an identifying account in order to play a jukebox song? Martin's conventional jukebox accepts coins or bills. Thus, Martin teaches away from providing an identifying account. Nor has any evidence been presented that clientele that frequent jukeboxes would agree to provide an identifying account (or any information that may identify them). The rejection is based on attempted impermissible hindsight reconstruction of Appellants' claimed invention. *In re Fritch*, supra. The Office has not established a *prima facie* case of obviousness.

Claim 56

Claim 56 depends on claim 55. The references further do not teach or suggest charging an inputted account an amount for the dispense of cash or digital content. Where do the

references teach or suggest an ATM that can charge an ATM user's account for playing a jukebox song, as apparently alleged in the Action? Martin's conventional jukebox accepts coins or bills. Twenty-five cent charges at a jukebox would not be cost efficient, practical, or obvious. Nor has any evidence been presented that the clientele that frequent jukeboxes would agree to setting up a charge account, let alone being required to go through the hassle of charging 25 cents to an account in order to hear a song. The Office has not established a *prima facie* case of obviousness.

Claim 57

Claim 57 depends on claim 56/55. The references further do not teach or suggest charging (by communicating with a financial transaction computer remotely located from the machine) an account read from a card an amount for the dispense of cash or digital content. The Office has not established a *prima facie* case of obviousness.

Claim 58

Claim 58 depends on claim 55. The references further do not teach or suggest providing an account (claim 55), and (responsive to a dispense input) recording digital content dispensed from the machine with a portable computing device. Where do the references record dispensed digital content with a portable computing device?

The Action (on page 7) admits that neither De Leo nor Martin teach or suggest a portable device. That is, the Action admits that the record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra.

Where do the references teach or suggest recording songs dispensed from an ATM jukebox, as apparently alleged in the Action? The Office has not established a *prima facie* case of obviousness.

Claim 59

Claim 59 depends on claim 58/55. The references further do not teach or suggest recording digital content dispensed from a machine by placing a portable computing device in releasable connection with the machine's output device. The Office has not established a *prima facie* case of obviousness.

Claim 60

Claim 60 depends on claim 58/55. The references further do not teach or suggest recording digital content dispensed from the machine with a portable computing device so that reproduction from the portable computing device is restricted. The Office has not established a *prima facie* case of obviousness.

Claim 61

Claim 61 depends on claim 55. Where do the references teach or suggest a relationship of providing account data, requesting a sound file, and receiving the sound file, as apparently alleged in the Action? The Office has not established a *prima facie* case of obviousness.

Claim 62

Claim 62 depends on claim 61/55. Nor do the references teach or suggest providing account data to an ATM, requesting a music file from the ATM, and receiving the music file from the ATM, as apparently alleged in the Action? The Office has not established a *prima facie* case of obviousness.

Claim 63

Nor do the references teach or suggest the recited digital content comprising a document file. The Office has not established a *prima facie* case of obviousness.

Claim 64

Nor do the references teach or suggest the recited digital content comprising an image file. Why would a jukebox dispense images, as apparently alleged in the Action? The Office has not established a *prima facie* case of obviousness.

Claim 65

Nor do the references teach or suggest the recited digital content comprising an audiovisual file. Why would a jukebox dispense audiovisual files, as apparently alleged in the Action? The Office has not established a *prima facie* case of obviousness.

Claim 66

Claim 66 depends on claim 55. Nor do the references teach or suggest providing account data, requesting digital content, and sending the requested digital content through a network to a network delivery address, as apparently alleged in the Action. The Office has not established a *prima facie* case of obviousness.

Claim 67

Claim 67 depends on claim 55. Nor do the references teach or suggest crediting a source account associated with a source of digital content responsive to dispense of the digital content from a cash dispensing automated transaction machine. Where do the references teach or suggest providing account data to an ATM, requesting a jukebox song from the ATM, playing the jukebox song from the ATM, and crediting a source account for the played jukebox song, as

apparently alleged in the Action? The Office has not established a *prima facie* case of obviousness.

Claim 68

Claim 68 depends on claim 55. Nor do the references teach or suggest crediting a licensing account associated with a licensing entity of digital content responsive to dispense of the digital content from a cash dispensing automated transaction machine. Where do the references teach or suggest providing account data to an ATM, requesting a jukebox song from the ATM, playing the jukebox song from the ATM, and crediting a licensing account for playing the jukebox song, as apparently alleged in the Action? The Office has not established a *prima facie* case of obviousness.

Claim 69

Claim 69 depends on claim 55. Nor do the references teach or suggest the additional steps of debiting an amount from an account associated with the account identifying input; crediting the amount to a prepay account; and debiting the prepay account responsive to the dispense of digital content. The Action is silent regarding the recited steps. The Office has not established a *prima facie* case of obviousness.

Claim 70

Claim 70 depends on claim 55. Nor do the references teach or suggest providing account identifying input, providing dispense input, and delivering sounds through a sound system of a cash dispensing automated transaction machine responsive to the dispense input. The Office has not established a *prima facie* case of obviousness.

Claim 71

Claim 71 depends on claim 55. Nor do the references teach or suggest dispensing audiovisual material through an audiovisual system of a cash dispensing automated transaction machine. The Office has not established a *prima facie* case of obviousness.

Claim 72

Claim 72 depends on claim 55. Nor do the references teach or suggest dispensing digital content with a printer of a cash dispensing automated transaction machine. The Action (on page 8) admits that neither De Leo nor Martin teach or suggest printing out the digital content. That is, the Action admits that the record lacks substantial evidence support for the rejection. *In re Zurko*, *supra*. *In re Lee*, *supra*. The Office has not established a *prima facie* case of obviousness.

Claim 73

Claim 73 depends on claim 70/55. For reasons already discussed, the references do not teach or suggest providing account identifying input, providing dispense input, delivering sounds through a sound system of a cash dispensing automated transaction machine responsive to the dispense input, and charging an establishment account responsive to the delivered sounds. The Office has not established a *prima facie* case of obviousness.

Claim 74

Claim 74 depends on claim 55. For reasons already discussed, the references further do not teach or suggest reproducing in a local content data store in a cash dispensing automated transaction machine, digital content from a remote content data store accessed by the machine through a network. The Office has not established a *prima facie* case of obviousness.

Claim 75

Claim 75 depends on claim 74/55. For reasons already discussed, the references further do not teach or suggest delivering the digital content from the local content data store of the cash dispensing automated transaction machine. The Office has not established a *prima facie* case of obviousness.

Claim 76

Claim 76 depends on claim 74/55. For reasons already discussed, the references further do not teach or suggest delivering the digital content from either the machine's local content data store or the remote content data store. The Office has not established a *prima facie* case of obviousness.

Claim 77

Claim 77 depends on claim 55. The references further do not teach or suggest providing account identifying biometric input at a cash dispensing automated transaction machine. The Action (on page 9) admits that neither De Leo nor Martin teach or suggest a biometric input/account identifying relationship for a cash dispensing automated transaction machine. That is, the Action admits that the record lacks substantial evidence support for the rejection. *In re Zurko*, *supra*. *In re Lee*, *supra*. The Office has not established a *prima facie* case of obviousness.

Claim 78

Claim 78 depends on claim 55. For reasons already discussed, the references further do not teach or suggest reproducing digital content (dispensed from a cash dispensing automated transaction machine) on a portable media. The Action (on page 7) admits that neither De Leo nor Martin teach or suggest portable media. That is, the Action admits that the record lacks

substantial evidence support for the rejection. *In re Zurko*, *supra*. *In re Lee*, *supra*. The Office has not established a *prima facie* case of obviousness.

Claim 79

Claim 79 depends on claim 78/55. The references further do not teach or suggest reproducing digital content (dispensed from a cash dispensing automated transaction machine) on a portable media taken from a supply of portable media in the machine. In an exemplary arrangement, an ATM can have a supply of blank CDs or other media, can copy the file onto the media, and can then deliver it to the ATM user (page 16, lines 12-13). Where does Martin's jukebox supply portable media for use in reproducing a song? The Office has not established a *prima facie* case of obviousness.

Claim 80

Claim 80 depends on claim 55. Nor do the references teach or suggest dispensing digital content from a cash dispensing automated transaction machine to portable media supplied by a user of the machine (e.g., page 16, line 11). The Action (on page 7) admits that neither De Leo nor Martin teach or suggest portable media. That is, the Action admits that the record lacks substantial evidence support for the rejection. *In re Zurko*, *supra*. *In re Lee*, *supra*. The Office has not established a *prima facie* case of obviousness.

Claim 81

Claim 81 depends on claim 55. For reasons already discussed, the references further do not teach or suggest the additional steps of receiving currency with a currency acceptor on the machine, and dispensing digital content responsive to the receipt of currency. The Office has not established a *prima facie* case of obviousness.

Claim 82

The references further do not teach or suggest computer readable media that can cause a cash dispensing automated transaction machine to carry out the dispensing of either cash from the machine or digital content, responsive to at least one account identifying input to an input device of the machine and at least one dispense input to an input device of the machine. Where do the references teach or suggest computer readable media that can cause a cash dispensing automated transaction machine processor to carry out such dispensing? The references do not teach or suggest the recited automated transaction machine computer readable media.

Even if it were somehow possible to have De Leo and Martin combined as alleged, the result still would not have produced the recited invention. The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified De Leo with the teaching of Martin to have produced the recited computer readable media of claim 82.

Claim 83

Claim 83 depends from claim 1. As previously discussed, the references, taken alone or in combination, do not teach or suggest a cash dispensing automated transaction machine apparatus that provides a user thereof the ability to cause a currency dispense responsive to a first input and cause a digital information file dispense responsive to a second input, especially where the second input “corresponds” to the digital information file.

Nor do the references teach or suggest a computer processor of an automated transaction machine apparatus that can cause a charge of at least one fee associated with a digital information file dispense (claim 83). Where do the references teach or suggest an automated transaction

machine apparatus that can cause the dispense of currency, can cause the dispense of a digital information file, and can charge a fee for the digital information file dispense? The Office has not established a *prima facie* showing of obviousness.

Claim 84

Claim 84 depends from claim 7. As previously discussed, the references, taken alone or in combination, do not teach or suggest an automated transaction machine that includes both a cash dispenser that can deliver cash responsive to input to an input device of the machine and an output device that can cause the delivery of digital content responsive to input of a digital content delivery fee authorization to an input device of the machine. That is, the references do not teach or suggest a cash dispensing automated transaction machine having an input device that can receive fee authorization for delivery of digital content, and an output device that can cause the delivery of the digital content responsive to the authorization. The references also not teach or suggest that the cash dispensing automated transaction machine can cause a charge of at least one fee associated with the delivery of digital content (claim 84). The Office has not established a *prima facie* showing of obviousness.

Claim 85

Appellants' remarks in support of the patentability of claims 1 and 7 are incorporated herein by reference. For reasons previously discussed, it would not have been obvious to one having ordinary skill in the art to have modified De Leo's ATM as alleged to have included Martin's jukebox. Nor would the alleged modification (if somehow even possible) have resulted in the recited invention.

Neither De Leo nor Martin, taken alone or in combination, disclose or suggest an automated transaction machine with the structural ability to receive currency dispense input, receive digital file selection input, receive digital file payment input, where the machine also includes both a currency dispenser device that can dispense currency and a file dispenser device that can cause the dispense of a selected digital file responsive to user input. Additional recited features and relationships not taught or suggested in the combined references have been previously discussed.

The combined references do not teach or suggest a currency dispensing automated transaction machine with the ability to receive user selection for a digital file (that is selectable to plural machine users), receive user payment for the selected digital file, and dispense the selected digital file. The Office has not established a *prima facie* showing of obviousness. Neither De Leo nor Martin, taken alone or in combination, disclose or suggest the recited apparatus.

The Office's allegations are not based on any evidence in the record. That is, the record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra. The rejection is based on attempted impermissible hindsight reconstruction of Appellants' claimed invention. *In re Fritch*, supra. The Action does not factually support any *prima facie* conclusion of obviousness. For reasons previously discussed, the Action is devoid of any teaching, suggestion, or motivation for combining the references to produce the recited apparatus. It would not have been obvious to one having ordinary skill in the art to have modified De Leo with the teaching of Martin as alleged to have produced the recited apparatus of claim 85.

Claim 86

Appellants' remarks in support of the patentability of claim 85 are incorporated herein by reference. For reasons previously discussed, it would not have been obvious to one having ordinary skill in the art to have modified De Leo's ATM to have included Martin's jukebox as alleged by the Office. Nor would the alleged modification (if somehow even possible) have resulted in the recited invention.

Neither De Leo nor Martin, taken alone or in combination, disclose or suggest receiving machine user selection for a digital file at a currency dispensing automated transaction machine, receiving machine user payment input for the selected digital file with the machine, and dispensing the selected digital file to the machine user responsive to user input to the machine. Additional recited features and relationships not taught or suggested in the combined references have been previously discussed. The Office has not established a *prima facie* showing of obviousness. Neither De Leo nor Martin, taken alone or in combination, disclose or suggest the recited method.

The Office's allegations are not based on any evidence in the record. That is, the record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra. The rejection is based on attempted impermissible hindsight reconstruction of Appellants' claimed invention. *In re Fritch*, supra. The Action does not factually support any *prima facie* conclusion of obviousness. For reasons previously discussed, the Action is devoid of any teaching, suggestion, or motivation for combining the references to produce the recited method. It would not have been obvious to one having ordinary skill in the art to have modified De Leo with the teaching of Martin as alleged to have produced the recited method of claim 86.

**The Claims Are Not Obvious Over
De Leo in view of Martin and Lotspiech**

Claims 8-12 and 36-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over De Leo in view of Martin and Lotspiech.

The Action (on pages 7 and 8) admits that De Leo/Martin does not teach or suggest the recited features and relationships.

Lotspiech cannot alleviate the previously noted deficiencies of De Leo/Martin with regard to claims 1-7, 13-35, and 45-86. Nor can Lotspiech alleviate the admitted deficiencies of De Leo/Martin with regard to claims 8-12 and 36-44.

Nor would it have been obvious to have combined the references as alleged. Lotspiech (like Martin) is non analogous art to both De Leo and the recited invention. Lotspiech is directed to renting music. Lotspiech (like Martin) is not pertinent to De Leo's cash dispensing ATM. It would not have been obvious to have modified De Leo's ATM to include Lotspiech's system for renting music. Likewise, it would not have been obvious to have modified Lotspiech's system for renting music to include an ATM.

The reason provided for combining the references is neither germane nor a valid reason for rejection. The Action (on page 7) states the reason to combine is "to accommodate those individuals who have disabilities and are not able to make use of the [cash dispensing automated transaction machine] apparatus in a public setting". If the individuals cannot use a publicly accessible ATM (as indicated by the Office), then how can they use a portable device (admitted as absent in De Leo/Martin) connected to the same ATM? Even if it were somehow possible

(which it is not) to have combined the references as alleged, the combination still would not have resulted in the recited invention.

The rejections are based on attempted impermissible hindsight reconstruction of Appellants' claimed invention. *In re Fritch*, supra. The Office has not established a *prima facie* case of obviousness.

Appellants also respectfully disagree with the Office's allegation (at Action page 8, with regard to claims 36-44) that "De Leo in view of Martin, and further in view of Lotspiech anticipates these claims".

Claim 8

Claim 8 depends from claim 7. The references, taken alone or in combination, further do not teach or suggest a cash dispensing automated transaction machine output device that can cause the delivery of digital content, and is releasibly operatively connectable to a portable computing device. The Office has not established a *prima facie* showing of obviousness.

Claim 9

Claim 9 depends from claim 8/7. The references, taken alone or in combination, further do not teach or suggest a cash dispensing automated transaction machine output device that can cause the delivery of digital content, especially where the output device comprises a communications port releasibly operatively connectable to a portable computing device adjacent the machine. The Office has not established a *prima facie* showing of obviousness.

Claim 10

Claim 10 depends from claim 9/8/7. The references, taken alone or in combination, further do not teach or suggest a cash dispensing automated transaction machine output device

that can cause the delivery of a sound file, especially where the output device comprises a communications port releasibly operatively connectable to a portable computing device adjacent the machine. The Office has not established a *prima facie* showing of obviousness.

Claim 11

Claim 11 depends from claim 10/9/8/7. The references, taken alone or in combination, further do not teach or suggest a cash dispensing automated transaction machine output device that can cause the delivery of a music file, especially where the output device comprises a communications port releasibly operatively connectable to a portable computing device adjacent the machine. The Office has not established a *prima facie* showing of obviousness.

Claim 12

Claim 12 depends from claim 9/8/7. The references, taken alone or in combination, further do not teach or suggest a cash dispensing automated transaction machine output device that can cause the delivery of an audiovisual file, especially where the output device comprises a communications port releasibly operatively connectable to a portable computing device adjacent the machine. The Office has not established a *prima facie* showing of obviousness.

Claim 36

Claim 36 depends from claim 31/13/7. The references further do not teach or suggest a cash dispensing automated transaction machine reproduction device that can reproduce digital content onto a portable storage medium. The Office has not established a *prima facie* showing of obviousness.

Claim 37

Claim 37 depends from claim 36/31/13/7. The references further do not teach or suggest that a cash dispensing automated transaction machine reproduction device that can cause digital content to be reproduced in a portable computing device releasibly operatively connectable with the machine. A *prima facie* case of obviousness has not been established.

Claim 38

Claim 38 depends from claim 37/36/31/13/7. The references further do not teach or suggest the ability to have digital content dispensed from a cash dispensing automated transaction machine to a portable computing device such that it can only be played in the portable computing device. The Office has not established a *prima facie* showing of obviousness.

Claim 39

Claim 39 depends from claim 37/36/31/13/7. The references further do not teach or suggest a cash dispensing automated transaction machine reproduction device that can reproduce digital content into a portable computing device such that it cannot be further transferred in digital form from the portable computing device. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 40

Claim 40 depends from claim 37/36/31/13/7. The references further do not teach or suggest a cash dispensing automated transaction machine reproduction device that can reproduce digital content into a portable computing device with a limited number of plays. The Office has not established a *prima facie* showing of obviousness.

Claim 41

Claim 41 depends from claim 37/36/31/13/7. The references further do not teach or suggest a cash dispensing automated transaction machine reproduction device that can reproduce digital content into a portable computing device such that it can only be played during a limited time period. Again, the Office has not established a *prima facie* showing of obviousness.

Claim 42

Claim 42 depends from claim 36/31/13/7. The references further do not teach or suggest a cash dispensing automated transaction machine including a supply of portable media, and a reproduction device of the machine can reproduce digital content onto portable storage media from the supply. A *prima facie* showing of obviousness has not been established.

Claim 43

Claim 43 depends from claim 8/7. The references further do not teach or suggest the ability of having digital content reproduced with restricted reproduction in a portable computing device. Where do the combined references teach or suggest restricting reproduction of digital content, especially with regard to a cash dispensing automated transaction machine that can cause the delivery of the digital content? The Office has not established a *prima facie* showing of obviousness.

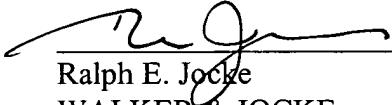
Claim 44

Claim 44 depends from claim 7. The references further do not teach or suggest a cash dispensing automated transaction machine including a supply of portable storage media, where the machine can cause digital content to be reproduced on portable storage media from the supply. Again, the Office has not established a *prima facie* showing of obviousness.

CONCLUSION

Each of Appellants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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(viii)

CLAIMS APPENDIX

1. An automated transaction machine apparatus comprising:

at least one computer processor;

at least one data store in operative connection with the at least one computer processor, wherein the at least one computer processor is operative to cause a plurality of digital information files to be retrieved from at least one digital information source located remotely from the machine and saved in the data store;

at least one user input device in operative connection with the at least one computer processor, wherein the at least one user input device is operative to receive user input;

a cash dispenser device in operative connection with the at least one computer processor, wherein the at least one computer processor is operative to cause the cash dispenser to dispense currency responsive to at least one first user input through the at least one user input device; and

at least one output device in operative connection with the at least one computer processor, wherein the at least one computer processor is operative to cause the

dispense of at least one of the digital information files through the at least one output device responsive to at least one second user input through the at least one user input device that corresponds to the at least one digital information file, and wherein the at least one computer processor is operative to cause the dispense of the same digital information file to plural users.

2. The apparatus according to claim 1 wherein the at least one user input device comprises a card reader device in operative connection with the computer processor, wherein the card reader device is operative to read account indicia from a card, and wherein the computer processor is operative to cause one or more fees to be charged to the account corresponding to the dispense of currency and the dispense of the at least one digital information file.
3. The apparatus according to claim 1, wherein the at least one digital information file includes a digital sound recording file.
4. The apparatus according to claim 3, wherein the at least one digital information file includes an MP3 file.
5. The apparatus according to claim 3, wherein the at least one output device includes a sound system, and wherein the computer processor is operative to cause the output of sound through the sound system responsive to the at least one digital information file.

6. The apparatus according to claim 1, wherein the computer processor is operative to cause a licensing fee associated with the at least one digital information file, to be transferred to a licensing entity.

7. Apparatus comprising:

an automated transaction machine including:

at least one input device;

a cash dispenser, wherein the cash dispenser is operative to deliver cash from the machine responsive to at least one input to the at least one input device;

at least one output device, wherein the at least one output device is operative to cause the delivery of digital content responsive to at least one digital content delivery fee authorization input to the at least one input device, and wherein the at least one output device is operative to cause the delivery of the same digital content to different entities.

8. The apparatus according to claim 7 wherein the at least one output device is releasibly operatively connectable to a portable computing device.

9. The apparatus according to claim 8 wherein the at least one output device comprises a communications port releasably operatively connectable to a portable computing device adjacent the machine.
10. The apparatus according to claim 9 wherein the digital content comprises at least one sound file.
11. The apparatus according to claim 10 wherein the at least one sound file comprises a music file.
12. The apparatus according to claim 9 wherein the digital content comprises at least one audiovisual file.
13. The apparatus according to claim 7 wherein the at least one input device is adapted to receive at least one input corresponding to an account, and wherein the machine further includes:

at least one processor, wherein the processor is in operative connection with the at least one input device, the cash dispenser and the at least one output device, and wherein the processor is operative to cause the account to be charged for at least one of delivered cash and digital content.

14. The apparatus according to claim 13 wherein the at least one input device includes a card reader, and wherein the input corresponding to an account is produced responsive to at least one card read by the card reader.
15. The apparatus according to claim 13 wherein the processor is operative to cause content indicia corresponding to a plurality of portions of the digital content to be output through the at least one output device, and wherein the processor is operative to cause a selected portion of the digital content to be delivered responsive to at least one selection input corresponding to the selected portion, through the at least one input device.
16. The apparatus according to claim 15 wherein the machine includes a display device and the content indicia is output through the display device.
17. The apparatus according to claim 16 wherein the content indicia includes a graphic image corresponding to at least one of the portions of the digital content.
18. The apparatus according to claim 13 wherein the apparatus comprises at least one content data store, wherein the digital content is delivered from the content data store.
19. The apparatus according to claim 18 wherein the content data store comprises a local content data store located in the machine.

20. The apparatus according to claim 18 and further comprising:

at least one network in operative connection with the machine; and

at least one remote computer in operative connection with the network, wherein the content data store is in the at least one remote computer.

21. The apparatus according to claim 20 and further comprising:

at least one financial transaction computer in operative connection with the at least one network, wherein the processor is operative to cause the account to be charged through communication with the at least one financial transaction computer through the at least one network.

22. The apparatus according to claim 18 wherein the at least one input device on the machine is operative to receive a network delivery address, and further comprising:

at least one network in operative connection with the machine, wherein the processor is operative to cause the digital content to be delivered through the at least one network to the network delivery address, whereby a remote computer corresponding to the network delivery address is enabled to receive the digital content.

23. The apparatus according to claim 19 and further comprising:

at least one network in operative connection with the machine; and

at least one remote computer in operative connection with the network, wherein
the at least one remote computer includes at least one remote content data store.

24. The apparatus according to claim 23, wherein the machine is operative to selectively
deliver digital content from either the local content data store or the remote content data
store responsive to at least one input to the at least one input device.

25. The apparatus according to claim 23 wherein the processor is operative to cause digital
content in the remote content data store to be stored in the local content data store.

26. The apparatus according to claim 25 wherein the processor is operative on a periodic
basis to cause selected digital content in the remote content data store to be stored in the
local data store.

27. The apparatus according to claim 26 wherein the selected digital content comprises at
least one sound file corresponding to at least one currently popular song.

28. The apparatus according to claim 26 wherein the selected digital content comprises at least one sound file corresponding to at least one currently popular book.

29. The apparatus according to claim 26 wherein the selected digital content comprises at least one audiovisual file corresponding to at least one currently popular movie.

30. The apparatus according to claim 27 wherein the selected digital content includes at least one graphic image corresponding to the at least one song.

31. The apparatus according to claim 13 and further comprising:
at least one network in operative connection with the machine,
at least one financial transaction computer in operative connection with the network, wherein the processor is operative to cause the account to be charged responsive to communication through the at least one network with the at least one financial transaction computer.

32. The apparatus according to claim 31 wherein the at least one financial transaction computer includes a source account associated with a source of the digital content, and wherein the source account is credited responsive to delivery of the digital content.

33. The apparatus according to claim 31 wherein the at least one financial transaction computer includes a licensing account associated with a licensing entity for the digital content, and wherein the licensing account is credited responsive to the delivery of the digital content.
34. The apparatus according to claim 31 wherein the account is associated with a user of the machine, and wherein the at least one financial transaction computer includes the account, and wherein the account is debited responsive to either delivery of cash or delivery of digital content.
35. The apparatus according to claim 31 wherein the at least one financial transaction computer holds a content prepay account for delivery of digital content, and wherein the processor is operative responsive to at least one input to at least one input device to cause funds to be transferred from the account to the content prepay account, and wherein the processor is operative to cause the content prepay account to be debited responsive to the delivery of the digital content.
36. The apparatus according to claim 31 wherein the output device includes a reproduction device operative to reproduce the digital content on a portable storage medium.

37. The apparatus according to claim 36 wherein the reproduction device is operative to cause the digital content to be reproduced in a portable computing device releasably operatively connectable with the machine.
38. The apparatus according to claim 37 wherein the digital content is reproduced in the portable computing device such that it can only be played in the portable computing device.
39. The apparatus according to claim 37 wherein the digital content is reproduced in the portable computing device such that it cannot be further transferred in digital form from the portable computing device.
40. The apparatus according to claim 37 wherein the digital content is reproduced in the portable computing device such that it can only be played a limited number of times.
41. The apparatus according to claim 37 wherein the digital content is reproduced in the portable computing device such that it can only be played during a limited time period.
42. The apparatus according to claim 36 wherein the machine includes a supply of portable media, and the reproduction device is operative to reproduce the digital content on the portable storage media from the supply.

43. The apparatus according to claim 8 wherein the digital content is reproduced in the portable computing device such that reproduction of the digital content is restricted.
44. The apparatus according to claim 7 wherein the machine further comprises a supply of portable storage media, and wherein the digital content is delivered by being reproduced on portable storage media from the supply.
45. The apparatus according to claim 31 wherein the at least one output device includes a sound system, and wherein the digital content is delivered through audio outputs through the sound system.
46. The apparatus according to claim 7 wherein the at least one output device includes a sound system, and wherein the digital content is delivered through audio outputs through the sound system.
47. The apparatus according to claim according to claim 31 wherein the at least one output device includes an audiovisual output device, and wherein the digital content is delivered as audiovisual outputs through the audiovisual output device.
48. The apparatus according to claim according to claim 7 wherein the at least one output device includes an audiovisual output device, and wherein the digital content is delivered as audiovisual outputs through the audiovisual output device.

49. The apparatus according to claim according to claim 31 wherein the at least one output device includes a printer device, and wherein the digital content is delivered by printing the digital content with the printer device.
50. The apparatus according to claim according to claim 7 wherein the at least one output device includes a printer device, and wherein the digital content is delivered by printing the digital content with the printer device.
51. The apparatus according to claim 46 wherein the machine is located in an establishment, and wherein the account charged for the delivered digital content is an account of an operator of the establishment.
52. The apparatus according to claim 48 wherein the machine is located in an establishment, and wherein the account charged for the delivered digital content is an account of an operator of the establishment.
53. The apparatus according to claim 7 wherein the automated transaction machine further comprises:

a currency acceptor, wherein the machine is further operative to deliver digital content responsive to deposit of cash into the currency acceptor.

54. The apparatus according to claim 47 wherein the automated transaction machine further comprises:

a currency acceptor, wherein the machine is further operative to deliver digital content responsive to deposit of cash into the currency acceptor.

55. A method comprising:

- (a) providing at least one account identifying input to the at least one input device of the automated transaction machine of claim 7;
- (b) providing at least one dispense input to the at least one input device of the machine;
- (c) dispensing either cash from the machine or digital content responsive to the at least one dispense input.

56. The method according to claim 55 and further comprising:

- (d) charging an amount for the dispense of cash or digital content, to an account associated with the at least one account identifying input.

57. The method according to claim 56 wherein step (a) comprises reading the account identifying indicia from a card with a card reader on the machine, and wherein step (d) comprises communicating with a financial transaction computer remotely located from the machine.
58. The method according to claim 55 wherein step (c) includes recording the dispensed digital content with a portable computing device.
59. The method according to claim 58 wherein step (c) includes placing the portable computing device in releasable operative connection with an output device on the machine.
60. The method according to claim 58 wherein in step (c) the recording is conducted such that reproduction from the portable computing device is restricted.
61. The method according to claim 55 wherein the digital content comprises a sound file.
62. The method according to claim 61 wherein the digital content comprises a music file.
63. The method according to claim 61 wherein the digital content comprises a document file.
64. The method according to claim 61 wherein the digital content comprises an image file.

65. The method according to claim 55 wherein the digital content comprises an audiovisual file.

66. The method according to claim 55 wherein in step (c) the dispense of digital content comprises sending the digital content through at least one network to a network delivery address.

67. The method according to claim 55 and further comprising:

(d) crediting a source account associated with a source of the digital content responsive to the dispense of digital content in step (c).

68. The method according to claim 55 and further comprising:

(d) crediting a licensing account associated with a licensing entity of the digital content responsive to the dispense of digital content in step (c).

69. The method according to claim 55 and further comprising:

(d) debiting an amount from an account associated with the account identifying input; and

- (e) crediting the amount to a prepay account;
- (f) debiting the prepay account responsive to the dispense of digital content in step (c).

70. The method according to claim 55 wherein in step (c) the dispense of digital content includes delivering sounds through a sound system.
71. The method according to claim 55 wherein in step (c) the dispensing of digital content includes delivering audiovisual material through an audiovisual system.
72. The method according to claim 55 wherein in step (c) the dispense of digital content includes printing digital content with a printer.
73. The method according to claim 70 wherein the machine is located in an establishment, and further comprising:

- (d) charging an account associated with the establishment responsive to the dispense of digital content.

74. The method according to claim 55 and further comprising:

d) reproducing in a local content data store in the machine, digital content from at least one remote content data store accessed through at least one network by the machine.

75. The method according to claim 74 wherein in step (c) the digital content is delivered from the local content data store.

76. The method according to claim 74 wherein in step (c) the digital content is delivered from either the local content data store or the remote content data store.

77. The method according to claim 55 wherein in step (a) the account identifying input comprises a biometric input from a user of the machine.

78. The method according to claim 55 wherein step (c) comprises reproducing the digital content on a portable media.

79. The method according to claim 78 wherein in step (c) the portable media is from a supply of portable media in the machine.

80. The method according to claim 55 wherein in step (c) the portable media is supplied by a user of the machine.

81. The method according to claim 55 and further comprising:

(d) receiving currency with a currency acceptor on the machine; and

(e) dispensing digital content responsive to the receipt of currency in step (d).

82. Computer readable media operative to cause at least one processor in the automated transaction machine to carry out step (c) recited in claim 55, responsive to performance of steps (a) and (b).

83. The apparatus according to claim 1 wherein the computer processor is operative to cause a charge of at least one fee associated with the dispense of at least one digital information file.

84. The apparatus according to claim 7 wherein the machine is operative to cause a charge of at least one fee associated with the delivery of digital content.

85. Apparatus comprising:

an automated transaction machine,

wherein the machine includes at least one input device,

wherein the at least one input device is operative to receive
machine user input corresponding to a currency dispense,

wherein the at least one input device is operative to receive
machine user input corresponding to selection of a digital file that
is selectable to plural machine users,

wherein the at least one input device is operative to receive
machine user input corresponding to a payment associated with
dispense of the selected digital file,

wherein the machine includes a currency dispenser device,

wherein the currency dispenser is operative to dispense currency,

wherein the machine includes a file dispenser device,

wherein the file dispenser device is operative to cause the dispense of the selected digital file responsive to at least one machine user input to the at least one input device.

86. A method comprising:

- (a) receiving, via at least one input device of an automated transaction machine having a currency dispenser operative to dispense currency, machine user input corresponding to selection of a digital file that is selectable to plural users of the machine;
- (b) receiving, via the at least one input device, machine user input corresponding to a payment associated with dispense of the selected digital file;
- (c) dispensing the selected digital file responsive to at least one machine user input to the at least one input device.

(ix)

EVIDENCE APPENDIX

(None)

(x)

RELATED PROCEEDINGS APPENDIX

(None)